REMARKS

It is noted with appreciation that there have been no rejections on prior art, and since claims of this application have been copied from issued patent 6,176,862 B1 (Delay et al.), they are understood to have been found by the Patent Office (through Primary Examiner John Wilson and Examiner Eduardo Robert) to comply with §112, 2nd para., and all other requirements of patentability. Applicants' priority filing date (June 14, 1995) and their PCT filing date (June 4, 1996) are each senior to both Delay et al.'s filing date (May 12, 1999) and his foreign priority date (September 16, 1997) by more than one year, and thus would be entitled to senior party status were Examiner to initiate an Interference proceeding.

Rejection under §112, first para.

The Examiner questioned use of the phrase the "elements are mounted in a fixed position on the roller." As had already been stated in the Remarks to the Preliminary Amendment, Delay gives a special, broad definition to the claim term that the pain-soothing elements are mounted in a "fixed position". Firstly, note that the elements can be either rigid or resilient, which is expressly stated in dependent claim 6; thus claim 1 encompasses pain-soothing elements that are rigid or elastic. Secondly, specifically according to the Delay disclosure, the protrusions themselves do not have to be made of a rigid material but can be flexible, as expressly stated at column 4, line 23. The specification gives several examples that flexible "semi-rigid pain-soothing elements [i.e, the protrusions] are thus produced in a simple manner, notably by the fact that they are carried in a flexible manner to offer a possibility of a whipping movement." (emphasis added). Delay claim 1 embraces such embodiments of this type of elastic protrusions disclosed in his specification as: silicone rubber prongs as in Fig. 2 (col. 5, ln. 35); thin flexible fingers as in Fig. 7b (col. 10, ln. 4); a tuft of filaments like bristles with an overmolded plastic ball head as in Fig. 10c, which is essentially a hinge joint (col. 11, ln. 14); or a thin flexible tongue as in Fig. 10b (col. 11, ln. 8). This is identical to Applicants' disclosed structure, see e.g. the embodiment at Figs. 8a-8b, or the embodiment at Fig. 9a-9c, or the embodiment at Fig. 6 (considering the subassembly comprising parts 16 and 33, the proximal end of 33 is fixedly retained), which each provides a "built-in" support at the mounting location to the rotary cylinder while the free end can move to impact and massage the skin (Delay et al. "whipping movement"). Thus, Delay claim 1 covers protrusions whose free, distal ends move relative to their mounting base portions during rotation of the

depilation cylinder; the "mounted in a fixed position" simply indicates that the protrusion's base portion does not move relative its attachment location to the rotary cylinder, and is identically taught in Applicants' disclosure.

To advance the prosecution, claim 24 is amended to recite that the ends of the elements that are proximal the roller are fixed to the roller. Amended claim 24 is supported in the present application's disclosure, e.g. the embodiments at Fig. 5, or Fig. 8, or Fig. 9, or Fig. 6. Claim 24 continues to correspond to Delay claim 1 (and its identical claim 17).

To further advance prosecution, claim 38 is amended. Firstly, it is amended to overcome the "double patenting" rejection (noting again, however, that if an Interference were declared, Delay's claims 1 and 17 must be considered together since they are identically worded). Secondly, claim 38 is now presented by deleting reference to the elements' mounting *in a fixed position* to the roller that the Examiner objected to as lacking support. Thus, amended claim 38 is no longer identical to claim 24. Claim 38 is now broader than Delay's claim 1 (or claim 17) and corresponds thereto.

To further advance prosecution, new claim 39 is added in which the objected-to expression is replaced with the feature that the elements are at a fixed *angular* position, as shown e.g. in the embodiment of Figure 8. This embraces both the mounting where the elements are capable of motion, e.g. radially outward, as well as the case of the elements being mounted static, e.g. either completely rigid or simply with static proximal ends but flexible skin-contacting distal ends, such as by a flexible element undergoing a whipping motion as disclosed in Delay, as discussed above. Thus, claim 39 corresponds to Delay claim 1.

Claim 27 is amended to delete reference to helical line and "staggered" rows. Claim 27 continues to correspond to Delay claim 4.

Claim 30 is amended to delete the language that is understood to be objected to by Examiner, and continues to correspond to Delay claim 7

Claim 31 is not amended, but rather support therefor is seen in the embodiment of Figure 8, the hair-feeding component 6 having a circular periphery, and the protuberances 35 being arranged on the periphery.

Claim 33 is likewise supported by the embodiment of Figure 8, the hair-feeding component 6 also functioning as a pedestal, and having the protuberances 35 mounted on an external face thereof.

It is requested that if Examiner considers maintaining any §112 rejections, that he first telephone the undersigned who will then cooperate with Examiner to quickly place the application in condition for the claims to be found patentable.

The present claims and claims of Delay are directed to the same invention:
Applicants re-present the following remarks that were made in the Preliminary Amendment:

The invention of the present claims has as its purpose, as Delay et al. '862 (hereinafter "Delay") states at column 3, lines 23-27, that the painful stimulus of the hair tweezing is masked by overloading the nerves through the additional imposed, repetitive mechanical stimulus to massage the skin in a comfortable manner (see also col. 8, ln. 35). The present application identically states that the overlaid pulse overshadows the actual epilating pain by saturating the nerve, see carryover text at page 2, lines 15 to page 3, line 8.

Delay uses pain-masking elements that are pins or protuberances that are at their base (or proximal) ends attached to the rotary member, and at their free, skin-engaging (or distal) end extend beyond the virtual cylinder (an imaginary mantel surface) inscribed around the roller. The specification teaches that to achieve the pain-masking result, the free end extends by an amount between 0.1 mm and 1mm (see Fig. 2, and e.g. col. 9, ln. 6); this falls within the identical range taught by the pain-masking elements of the present invention, which extend beyond the virtual cylindrical surface by a similar amount of 0.1 mm to 6 mm, see specification at page 14, line 34 and e.g. Figures 2, 8 or 9.

If either of claim 38 or 39 were found patentable but not claim 24, then Applicants request the opportunity, even after a final office action, to rewrite the dependent claims as being dependent

from claim 38 or 39. This is not presently done in the interests of efficient resolution of the proceeding.

Rejection under §112, second para.

Claim 28 is amended for grammer to delete a superfluous word ("to") at line 1, thereby overcoming the §112, second para. rejection. Claim 28 continues to correspond identically to Delay claim 5.

If a telephone conference would helpfully advance prosecution, the Examiner is invited to telephone the undersigned at 617-421-7939. Please apply any charges or credits to Deposit Account No. 07-1350.

Respectfully submitted,

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APPENDIX

Marked-Up Version showing additions and deletions

In the Claims:

--24. (Amended). Hair-removing device comprising:

a hair-removal roller driven in rotation by a motor around an axis of rotation arranged behind a housing window, said roller comprising a plurality of tweezing blades arranged in at least one row, each of said tweezing blades having a tweezing edge,

control means for successively leading said tweezing blades to close against one another in order to tweeze hairs to be plucked and then to separate from one another; and

a pain-soothing device comprising elements mounted on said roller, wherein

said elements having ends proximal the roller [are] mounted in a fixed position on said roller and each element has at least one protuberance extending beyond a virtual cylinder coaxial with said roller and in which are inscribed said tweezing edges of said tweezing blades,

each said protuberance has an outer end that is at least one of inclined and rounded along a plane that is transverse to the axis of rotation of said roller and that passes through said element from which said protuberance extends and

each said element has a stiffness and dimensions selected to cause each said protuberance, when said roller is rotating and is disposed against a user's skin, to contact the skin and then press into the skin to perform a massaging action and to create a pain masking that of the hair removal.

--27. (Amended). Hair-removing device according to claim 24, wherein said elements are arranged on the roller in a series in an elongated zone covering substantially the length of the roller, and are distributed along one of: a straight line; [a helical line;] and in [staggered] rows.

--28. (Amended). Hair-removing device according to claim 24, wherein said elements are either connected [to] on a part of said roller, or are formed in one piece with said part.

--30. (Amended). Hair-removing device according to claim 24, wherein said elements are present in the form of at least one radial plate having an external edge, or a bar having an external edge [extending parallel to the axis of rotation between lateral cheeks of said roller], said external edge

of said plate or of said bar protruding beyond the virtual cylinder [and being straight, undulating, or toothed].

-- 38. (Amended). Hair-removing device comprising:

a hair-removal roller driven in rotation by a motor around an axis of rotation arranged behind a housing window, said roller comprising a plurality of tweezing blades arranged in at least one row, each of said tweezing blades having a tweezing edge,

control means for successively leading said tweezing blades to close against one another in order to tweeze hairs to be plucked and then to separate from one another; and

a pain-soothing device comprising elements mounted on said roller, wherein

said elements are mounted [in a fixed position] on said roller and each element has at least one protuberance extending beyond a virtual cylinder coaxial with said roller and in which are inscribed said tweezing edges of said tweezing blades,

each said protuberance has an outer end that is at least one of inclined and rounded along a plane that is transverse to the axis of rotation of said roller and that passes through said element from which said protuberance extends and

each said element has a stiffness and dimensions selected to cause each said protuberance, when said roller is rotating and is disposed against a user's skin, to contact the skin and then press into the skin to perform a massaging action and to create a pain masking that of the hair removal.--